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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/042,961

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Debora Margaret Hejzza Litwiller

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Patent Documentation Center

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EXAMINER

PITARO, RYAN F

ART UNIT

PAPER NUMBER

2174

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/042,961

Applicant(s)

LITWILLER, DEBORA MARGARET  
HEJZZA

Examiner

Ryan F Pitaro

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-45 have been examined.

#### *Specification*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

**The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.** The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The disclosure is objected to because of the following informalities: On page 5 lines 18-25 the applicant makes two different references to item 5 of Figure 1. Examiner suggests removing the reference to the drawing from the remote image form device or adding a separate reference to the drawing. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claim 16 is directed to an

apparatus, while the body of the claim is directed to a method. The claim, as an apparatus claim, lacks the elements that make the apparatus.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-4,6-10,16-19, 21-25, 31-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Unno ("Unno", US 6,437,875).

As per independent claim 1, Unno discloses a method for modifying a message in an apparatus prior to sending the message to a receiver (Figure 24), the message comprising a plurality of parameters, each parameter having a parameter value, each parameter value initially set to a default value (Figure 24 item 3215), the method comprising determining when the user wants to modify at least one parameter and, when it is determined that the user wants to modify at least one parameter, for each parameter of the plurality of parameters, determining when the user wants to modify the parameter (Figure 24 item 3215).

As per claim 2, which is dependent on claim 1, Unno discloses a method comprising when it is determined that the user wants to modify the parameter, displaying a plurality of choices to the user, determining a user selection based on the plurality of choices and modifying the parameter value based on the user selection (Figure 44).

As per claim 3, which is dependent on claim 2, Unno discloses a method comprising retaining the corresponding parameter default value when the user does not make a selection based on the plurality of choices (Figure 44 items 3375,3377,3379; *each pull down menu inherently has a default value in this case A3 300 Gray*).

As per claim 4, which is dependent on claim 1, Unno discloses a method comprising when it is determined that the user does not want to modify the each parameter, retaining the corresponding parameter default value (Figure 44 items

3375,3377,3379; *each pull down menu inherently has a default value in this case A3 300 Gray*).

As per claim 5, which is dependent on claim 1, Unno discloses a method wherein the displaying is performed by means of an LCD display screen (Column 7 lines 8-11).

As per claim 6, which is dependent on claim 1, Unno discloses a method wherein each parameter is based on the receiver (Column 13 lines 30-33).

As per claim 7, which is dependent on claim 6, Unno discloses a method wherein the plurality of parameters comprises a receiver resolution, a compression and a paper size (Column 13 lines 30-33).

As per claim 8, which is dependent on claim 1, Unno discloses a method wherein the message comprises an e-mail message (Column 17 lines 40-49).

As per claim 9, which is dependent on claim 1, Unno discloses a method wherein the message comprises a facsimile message (Column 17 lines 40-49)..

As per claim 10, which is dependent on claim 1, Unno discloses a method wherein the method comprises sending the message (Figure 24; send).

As per claim 11, which is dependent on claim 10, Unno discloses a method wherein the sending comprises transmitting the message to the remote receiver by means of a communication network (Figure 13).

As per claim 12, which is dependent on claim 11, Unno discloses a method wherein the communication network comprises an internet (Figure 1 item 1012).

As per claim 13, which is dependent on claim 1, Unno discloses a method wherein the apparatus comprises an image-forming device (Column 5 lines 13-16).

As per claim 14, which is dependent on claim 13, Unno discloses a method wherein the image-forming device comprises a facsimile machine (Column 5 lines 18-24).

As per claim 15, which is dependent on claim 13, Unno discloses a method wherein the image forming device comprising a printing machine (Column 5 lines 15-16).

Claim 16 is similar in scope to that of claim 1, and is therefore rejected under similar rationale.

Claim 17 is similar in scope to that of claim 2, and is therefore rejected under similar rationale.

Claim 18 is similar in scope to that of claim 3, and is therefore rejected under similar rationale.

Claim 19 is similar in scope to that of claim 4, and is therefore rejected under similar rationale.

Claims 20 and 35 are similar in scope to that of claim 5, and are therefore rejected under similar rationale.

Claims 21 and 36 are similar in scope to that of claim 6, and are therefore rejected under similar rationale.

Claims 22 and 37 are similar in scope to that of claim 7, and are therefore rejected under similar rationale.

Claims 23 and 38 are similar in scope to that of claim 8, and are therefore rejected under similar rationale.

Claims 24 and 39 are similar in scope to that of claim 9, and are therefore rejected under similar rationale.

Claim 25 is similar in scope to that of claim 10, and is therefore rejected under similar rationale.

Claims 26 and 33 are similar in scope to that of claim 11, and are therefore rejected under similar rationale.

Claims 27 and 34 are similar in scope to that of claim 12, and are therefore rejected under similar rationale.

Claims 28 and 40 are similar in scope to that of claim 13, and are therefore rejected under similar rationale.

Claims 29 and 41 are similar in scope to that of claim 14, and are therefore rejected under similar rationale.

Claims 30 and 42 are similar in scope to that of claim 15, and are therefore rejected under similar rationale.

As per independent claim 31, Unno discloses a method for modifying a message in an apparatus prior to sending the message to a receiver (Figure 24), the message comprising a plurality of parameters, each parameter having a parameter value, each parameter value initially set to a default value (Figure 24 item 3215), the plurality of message parameters thus initially having a corresponding plurality of parameter default values, the method comprising the steps of: determine when the user wants to modify at least one parameter (Figure 24 item 3215); when it is determined that the user does not want to modify at least one parameter, retain the plurality of parameter default values;



when it is determined that the user wants to modify at least one parameter, for each parameter of the plurality of parameters: determine when the user wants to modify the parameter; when it is determined that the user does not want to modify the parameter (Figure 44), retain the corresponding parameter default value; when it is determined that the user wants to modify the parameter, display a plurality of choices for the user; determine when the user makes a selection based on the plurality of choices (Figure 44); when it is determined that the user has made a selection based on the plurality of choices, modify the parameter value based on the user selection; and when it is determined that the user has not made a selection, retain the corresponding parameter default value (Figure 44 items 3375,3377,3379; *each pull down menu inherently has a default value in this case A3 300 Gray*).

As per claim 32, which is dependent on claim 31, Unno discloses a method including a subsequent step of sending the message (Column 15 lines 62-66).

As per claim 43, which is dependent on claim 1, Unno discloses a method wherein the user selection determining is performed by means of a touch-sensitive display screen (Column 7 lines 8-16).

Claims 44 and 45 are similar in scope to that of claim 43, and are therefore rejected under similar rationale.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- 5854693 teaches an image forming system featuring an interface on a printing machine with different parameters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F Pitaro whose telephone number is 571-272-4071. The examiner can normally be reached on 7:00am - 4:30pm Monday-Thursday, and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan Pitaro  
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RFP

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